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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,474	08/29/2001	Yasuo Shinohara	Q65911	4884
7590	01/11/2005		EXAMINER	
SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC 2100 Pennsylvania Avenue, N.W. Washington, DC 20037-3213			WILLS, MONIQUE M	
			ART UNIT	PAPER NUMBER
			1746	

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/940,474	SHINOHARA ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Monique M Wills	1746

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 26 October 2004.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,2 and 4-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,2 and 4-11 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. _____.   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

**DETAILED ACTION*****Response to Arguments***

This Office Action is responsive to the Amendment filed October 26, 2004. The rejection of claim 8 under 35 U.S.C. 112, second paragraph, is overcome. However, the rejection of claims 1-2 & 4-11 under 35 U.S.C. 102(e) as being anticipated by Shinohara et al., U.S. Patent 6,447,958 stands. A brief reiteration is recited below.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2 & 4-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Shinohara et al., U.S. Patent 6,447,958.

The applied reference has a common inventor and assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this

application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

Shinohara teaches a non-aqueous electrolyte battery separator comprising a heat-resistant nitrogen-containing aromatic polymer and a ceramic powder (abstract). With respect to claim 1, Shinohara teaches a separator comprising: a thermoplastic polymer fiber substrate, embracing the instant shut-down layer (col. 5, lines 40-55); a microporous heat-resistant nitrogen-containing aromatic polymer (col. 2, lines 45-55) with a porosity of less than 1Tm (col. 10, lines 40-50); and a thermoplastic spacer formed from a fine particle-like suspension (col. 10, lines 1-10). The particle coating, at column 10, lines 1-10, embraces Applicant’s spacer, because it separates the surface of the heat-resistant layer from an adjacent electrode. See column 10, lines 1-5, and column 13, lines 18-23. With respect to claim 2, the heat resistant layer consists of a para-aramid porous resin (col. 4, lines 23-28). With respect to claim 5, the spacer is formed of particles with a diameter of 1 $\mu$ m (col. 14, lines 45-53). With respect to claims 7 & 8, the spacer is formed by coating a liquid suspension on the surface of a heat-resistant microporous layer (col. 14, lines 44-53). With respect to claim 9, the spacer consists of an electrochemically stable polyolefin (col. 14, lines 43-53). With respect to claim 10, the separator is employed in a non-aqueous electrolyte secondary battery (col. 1, lines 5-10). With respect to claim 11, the spacer is adjacent the cathode, because the spacer forms the top layer of the separator (col. 14, lines 45-53) and the battery is laminated in the order of cathode, separator and anode (col. 13, lines 15-25). Therefore, the instant claims are anticipated by the prior art set forth. The limitation in claim 1, with respect to separator comprising a shut-down layer, is considered to be an inherent property of substrate as set forth in the prior art, because Shinohara teaches a substrate made of thermoplastic polyolefins and polyesters (col. 5,

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lines 40-50), which have melting temperatures suitable for shut-down (col. 6, lines 15-20). The employment of a polyester substrate is exemplified at column 14, lines 15-20. The limitation in claim 1, with respect to the heat-resistant layer being microporous, is considered to be an inherent property of the separator as set forth in the prior art, because the separator of Shinohara has void spaces of less than 1  $\mu\text{m}$  (col. 10, lines 25-50). The limitation in claim 1, with respect to the heat-resistant layer having a temperature of deflection under load of 18.6 kg/cm<sup>2</sup> pf 100°C, is considered to be an inherent property of the para-aramid porous resin as set forth in the prior art, because Shinohara employs the same heat-resistant resin material set forth by Applicant. Applicant's specification at page 6, lines 12-15, discloses that aramide polymers have a temperature of deflection under load of 18.6 kg/cm<sup>2</sup> pf 100°C or more. The limitation in claims 4 & 6, with respect to the spacer being an electrochemically stable polymer (claim 4), wherein the static friction coefficient between the spacer-disposed separator surface and a stainless steel surface ground by a 1000 grit polishing paper is 0.5 or less, is considered to be an inherent property of the spacer as set forth in the prior art, because Shinohara employs the same polyolefin spacer material set forth by Applicant.

*Response to Arguments*

Applicant's arguments, with respect to Shinohara not teaching a spacer is unconvincing. Specifically, the Applicant submits that the particle coating of Shinohara does not encompass the presently claimed spacer. To the contrary, the particle coating is a spacer because it separates the surface of the heat-resistant layer from an adjacent electrode. See column 10, lines 1-5 and column 13, lines 18-23. Furthermore, Applicant contends that the particle coating functions as a shut-down layer and instead of a spacer. Irrespective of the functioning of the particle coating set forth by

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Shinohara, the particle coating is a layer that provides space between objects it is interposed between. Therefore, the particle coating has a dual function of both a shut-down layer and a spacer. Unless Applicant can demonstrate a structural difference between the spacer claimed and the shut-down layer of Shinohara, the reference remains anticipatory.

*Conclusion*

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Monique Wills whose telephone number is (571) 272-1309. The Examiner can normally be reached on Monday-Friday from 8:30am to 5:00 pm.

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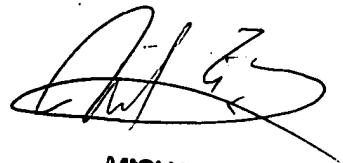
If attempts to reach Examiner by telephone are unsuccessful, the Examiner's supervisor, Michael Barr, may be reached at 571-272-1414. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MW

1/7/05



MICHAEL BARR  
SUPERVISORY PATENT EXAMINER